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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,538	05/24/2006	Enrico Ghini	2520-1063	3044

466 7590 01/26/2010
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209 Madison Street
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EXAMINER

SCHATZ, CHRISTOPHER T

ART UNIT	PAPER NUMBER
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1791

NOTIFICATION DATE	DELIVERY MODE
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01/26/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/550,538	Applicant(s) GHINI, ENRICO	
	Examiner CHRISTOPHER SCHATZ	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 14 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/06/2009.

Claim Objections

2. Applicant is advised that should claim 5 be found allowable, claim 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-13 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claim 1 recites "the same container". There is insufficient antecedent basis for this limitation in the claim. It is not clear to what container the applicant is referring. The claim also recites "the rest position". There is insufficient antecedent basis for this limitation in the claim.

6. Regarding claim 4, the phrase "particularly" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Claim 4 recites "the upper edge". There is insufficient antecedent basis for this limitation in the claim.

7. Regarding claim 5, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Claim 5 recites "the surface of the central body". It is not clear to what surface the applicant is referring. Claim 5 recites "the thickness of the wall". There is insufficient antecedent basis for this limitation in the claim.

8. Regarding claim 12, the phrase "e.g." renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

9. Regarding claim 13, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

10. Claim 9 recites the limitation "the injector body" in the last line of the claim. There is insufficient antecedent basis for this limitation in the claim.

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11. As to claims 6 and 18-20, it is not clear what a "thickening" is. Based on the specification it is believed that the applicant intended to claim an inner ring on the bottom of the outer body. For the purposes of this action the claim will be examined as such. It is recommended that applicant amend the claim to more clearly define what a "thickening" is. Additionally, it is not clear what "realizing a sealing ring" means. The claim does not associate any structural or physical limitations with the sealing ring such as where the ring is placed. Clarification is requested.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-3, 6, 8, 9-12, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (US 4976798) in view of Eiban et al. (US 20020002812).

Hoffman discloses a device for applying and heat-shrinking plastics labels, characterized in that it comprises a central body (28 or shaft under 74) and an outer body (18 or 72), coaxially movable one within the other one (figures 2, 3, 11, 12; column 3, lines 20-25), positioned in such a way to realize an interspace 20 (also see space between shaft support 74 and 72 in figure 12) between said bodies, and shaped in such a way as to receive a label to be applied, and to position the same about the outer surface of the same container, being provided means for introducing hot air into said

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interspace (the blow in figures 12 and 3 are capable of blowing into the interspace) so as to realize heat-shrinking of the label, being further provided means to bring the outer body back in the rest position (figures 1-3, 11, 12, column 3, lines 22-28). It is not clear if Hoffman discloses an injector element.

Eiban discloses a device capable of applying a label to a bottle, wherein an injector element is used to move one coaxial body 5 within another coaxial body 4 (figure 2, paragraphs 18-19). The inner body 5 is moved within the other body by the action of an injector element 11. At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the device of Hoffman by adding an injector element capable of moving the one body within the other body as taught by Eiban as doing such would enable the body to move in a highly controlled an efficient manner (paragraphs 18-19, 4).

As to claim 2, the central body is coupled to a base (column 3, lines 25-30). As to claim 3, in the modified device the central body will be hollow in order to accommodate the spring of Eiban. As to the other limitations, changes in shape are a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration is significant. MPEP 2144.06 IV (B). As to claim 8, Eiban discloses a spring. As to claim 9, the shape of the base is within the purview of one of ordinary skill in the art (see claim 3 above). As to claim 10, applicant's claimed coupling means is known in the art. As to claim 11, the injector element of Eiban is capable of being inserted into the central body of Hoffman. As to claim 12,

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Eiban discloses the injector element having a vertical stroke obtained by actuating means (figure 2).

As to claims 6, 18 and 19, Hoffman discloses that the outer body is comprised of a cylindrical tube having an inner diameter larger than the outer diameter of said central body (see figures 1-3 and 11 and 12). The tube is coaxially mounted on the same central body. Both embodiments show a thickening portion (70 in figures 11 and 12). It is not clear if there is a sealing ring. However, Eiban discloses a sealing ring 13 between two coaxial cylinders movable within each other. At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the device of Hoffman such that there is a sealing ring between the two coaxial movable bodies as taught by Eiban as such is known in the art. Use of the sealing ring aids in controlling the relative movement between the coaxial bodies.

14. Claims 4, 5, 7, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Eiban as applied to claims 1 and 6 above, and further in view of Marsetti (US 6260245).

Marsetti discloses outer 8 and central 11 cylinders movable coaxially with respect to each other, wherein the central cylinder has grooves 14a that are longitudinally oriented. The grooves enter into the appendices 14 projecting from inner surface of the outer cylindrical (figures 3b and 4b) and enable the cylinders to move only coaxially with respect to each other (column 2, lines 8-18). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the device of

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Hoffman as modified by Eiban by forming grooves on the surface of the central body and complementary projecting appendices on the surface of the outer body as taught by Marsetti above as doing such would enable the two bodies to move only coaxially with respect to each other. The number and depth of the grooves is a matter of design choice and well within the purview of one of ordinary skill in the art.

As to claim 20, the applicant is referred to the discussion of claim 6 above.

15. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and Eiban as applied to claims 11 and 11 above, and further in view of Dickey (US 4923557).

Marsetti discloses a device that applies hot air directly to unsupported sections of a label on a bottle (figure 7). Marsetti further discloses that such a manner of heating the label is advantageous because doing such prevents the label from bending or warping (column 9, lines 25-31). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the device of Hoffman as modified by Eiban by coupling the injector element with flow generated from a heat source as doing such would enable the modified apparatus to direct air at the supported section of the label and achieve the advantages discussed by Marsetti above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER SCHATZ whose telephone number is

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571-272-6038. The examiner can normally be reached on Monday through Friday 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTOPHER SCHATZ/
Examiner, Art Unit 1791

/Richard Crispino/
Supervisory Patent Examiner, Art Unit 1791